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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/960,762      09/21/2001      Ward W. Chilton      0112300-811      6315

29159      7590      08/12/2003

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EXAMINER
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JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

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DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/960,762

Applicant(s)

CHILTON ET AL.

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed March 5, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the items cited under the "Other Documents" section that have a line drawn through them lack a date in at least a month/year format. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 29 recites the limitation "the primary game" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-18, 32-37, 39-41, and 43-48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19-29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1).

Cannon and Cannon et al. each disclose all of the claimed subject matter except for the game being implemented in a bonus game. However, to one having ordinary skill in the art at the time of Applicant's invention it was notoriously well known to implement any type of game in a bonus game on a gaming machine. One would be motivated to do so because bonus games in gaming machines offer awards in addition to base game awards making gaming machines with bonus games very appealing to players.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Vazquez, Jr. et al. (U.S. 4,695,053).

Cannon and Cannon et al. each disclose all of the claimed subject matter except for a bonus game including a plurality of player selectable selections and wherein the qualifying outcome is associated with at least one selection (claim 30).

Vazquez, Jr. et al., like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Vazquez, Jr. et al., Cannon, and Cannon et al. are analogous art. Vazquez, Jr. et al. teaches of a gaming device wherein a player selects three digits on a display. The player then rotates the reels by pulling the gaming machine handle to produce a randomly generated outcome. The gaming device then determines whether any of the player selected numbers are obtained on the win line. The player is awarded if the player selected numbers match one, two, or three of the numbers that are randomly generated on the reels (column 1, line 40-column 6, line 16).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Vazquez's player selectable winning combination feature in Cannon or Cannon et al. One would be motivated to do so because allowing a player to select a winning combination would make a player feel like they have control over whether they will qualify for a future event or tournament.

10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Take Your Pick.

Cannon and Cannon et al. each disclose all of the claimed subject matter except for a bonus game including a player offer acceptance type game and the qualifying outcome is associated with one of a plurality of offers made to the player (claim 31).

Take Your Pick, like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Take Your Pick, Cannon, and Cannon et al. are analogous art. Take Your Pick teaches of a player offer acceptance type game wherein the outcome is associated with one of a plurality of offers made to the player. It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Take Your Pick player offer acceptance type game in Cannon or Cannon et al. One would be motivated to do so because allowing a player to accept or reject an outcome would make a player feel like they have control over whether they will qualify for a future event or tournament. Furthermore, this feature breathes new life into a gaming machine game, giving the player the thrill of taking a risk and the opportunity to actually employ a bit of strategy to a game that traditionally is based solely on dumb luck.

11. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon (U.S. 2002/0177483 A1) or Cannon et al. (U.S. 2002/0039923 A1) in view of Weiss (U.S. 6,309,299). Cannon and Cannon et al. each disclose all of the claimed subject matter except for a theme of a tournament is related to the theme of the qualifying gaming devices (claim 42). Weiss, like Cannon and Cannon et al., teach of games that are played on gaming machines, such as slot machines. Therefore, Weiss, Cannon, and Cannon et al. are analogous art. Weiss teaches of a game device and method for head to head or tournament play. In particular, Weiss teaches of a gaming device based on a battleship game theme for tournament play (Figs. 1-6 and column 2,

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line 40-column 3, line 2). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate a theme of the gaming device in the theme of the tournament. One would be motivated to do so because particular themes, such as battleship, are very familiar and popular with game players thereby increasing player participation and profit for casino operators.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lermusiaux '885, Kelly et al. '344, and Walker et al. '606 disclose tournament games implemented in gaming machines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej

August 6, 2003



**MICHAEL O'NEILL  
PRIMARY EXAMINER**